

Application No.: 09/669,869
Filing Date: September 21, 2000

REMARKS

Claims 1-13 and 16-53 remain pending in this application. The Examiner has withdrawn Claims 29-35 and 46-53 from consideration. Claims 13, 22 and 36 have been amended.

Withdrawal of Claims 29-35 and 46-53

The Examiner withdrew Claims 29-35 and 46-53 (the “method claims”) from consideration in this application, contending that they are directed to a non-elected invention. When taking this action, the Examiner referred to these claims as “Newly submitted”. (Office Action §2). Applicants respectfully traverse the Examiner’s withdrawal of these claims, and contend that any restriction/constructive election is untimely and inappropriate.

Applicants note that Claims 29-35 were added by amendment on December 13, 2002, Claims 46-53 were added by amendment on October 9, 2003. These claims have been specifically addressed by previous examiners in several previous Office Actions, and in response Applicants have made arguments and amendments specifically addressing these claims.

Restriction is Not Timely, And Imposes A Serious Burden On Applicants

Pursuant to 37 C.F.R. § 1.142(a) and M.P.E.P. § 811, a restriction requirement should be made “as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.” (emphasis added). In this application, prosecution has been under way since the first Office Action was mailed on October 4, 2001. As discussed above Claims 29-35 have been pending and prosecuted in this application for over 6 years, and Claims 46-53 have been pending and prosecuted in this application for about 5 ½ years.

In the over six years of prosecution since Claims 29-35 were added, Applicants and the PTO have exchanged at least 9 substantive communications. During this extensive prosecution no restriction requirement was deemed necessary by the Examiner. Applicants thus invested substantial time, effort and expense in prosecuting this application, and have overcome substantial rejections of the claims, including rejections of Claims 29-35 and 46-53. It seems implausible that a “need for a proper requirement” has suddenly developed.

Further, the claims that would be withdrawn from the application as a result of this restriction requirement are substantively similar to their form when originally added several years ago. Thus, no new substantive subject matter has been added to these claims. Again, it seems inconceivable that a need has developed to restrict out these claims.

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If this restriction requirement stands, Applicants would be forced to withdraw independent claims that have been pending and prosecuted over the last 5-6 years.

Applicants submit that it is unreasonable to conclude that a need for a proper restriction requirement has suddenly arisen in this case, as there has been no action by Applicants to prompt such a need, and the claims at issue have been pending and prosecuted for 5-6 years.

There Is No Serious Burden on the Examiner That Would Justify Restriction

Pursuant to M.P.E.P. § 808.02, “the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.” (emphasis added).

All of Claims 29-35 and 46-53 have been pending for several years and have been specifically addressed by examiners in multiple office actions. As such, substantive concerns about these claims have been raised and resolved, thus narrowing the issues currently outstanding for the Examiner to address. Also, the Examiner has not presented an explanation as to why there would be a serious burden on him unless restriction is required. In fact, restriction would impose a burden on the Applicants, as the benefit of several years of prosecution would be lost from this application.

The Constructive election/restriction imposed by the Examiner in the outstanding Office Action is untimely and imposes an unnecessary and unfair burden on the Applicants while providing no real benefit to the Examiner. Applicants thus respectfully request that the Restriction be withdrawn, and Claims 29-35 and 46-53 be returned to consideration in this application.

Rejections Under 35 U.S.C. § 103(a)

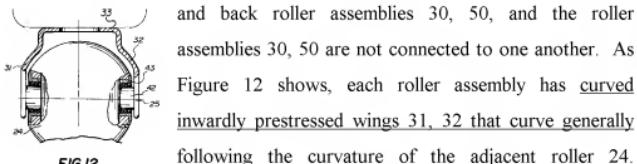
The Examiner rejected all of the pending claims under 35 U.S.C. § 103(a) as unpatentable over certain combinations of U.S. Patent No. 5,553,740 to Lin, U.S. Patent No. 4,034,995 to Forward and U.S. Patent No. 5,505,470 to Hoshizaki. Applicants respectfully traverse the combination of Lin and Forward. Further, certain of the claims have been amended, and Applicants contend that all of the pending claims currently are in condition for allowance.

Lin/Forward Combination

The Examiner rejected Claims 1, 4, 5, 6, 12, 13, 17-20, 22-24, 26-28, 36-38, 40-43 and 45 under 35 U.S.C. § 103(a) as unpatentable over Lin in view of Forward.

Lin teaches (see Figure 1 adjacent) an inline skate chassis having a front bracket 20, a rear bracket 30, and a channel piece 10 extending therebetween. The channel piece 10 has sideplates 11 that are parallel to one another. The front bracket 20 (see Figure 2 below) has legs 22 that extend downwardly to overlap the outside faces of the sideplates 11, and hooks 23 that rest on the top edge of each sideplate 11 to support the bracket, as shown in Figure 2. The rear bracket 30 similarly has legs 32 that overlap outer surfaces of sideplates and hooks 33 that rest on the top edges of the sideplates 11 to support the bracket 30. Notably, the legs 22, 32 are formed separately from the channel piece 10 and do not extend the length of the chassis. Also, the hooks 23, 33 appear to only rest upon the sideplates 11, and the brackets 20, 30 are only connected to the channel piece 10 by bolts through attached wheels. Also, the sideplates 11 and legs 22, 32 are not coplanar. Further, the channel piece has webs at two different levels, both higher than and lower than axles for the wheels.

Forward teaches a two-wheeled skate with spheroidal rollers. As shown, the front and back rollers 24 are supported by corresponding front



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Combination With Lin Would Change Forward's Principle of Operation

M.P.E.P. §2143.01(IV) states,

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (Citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959)(emphasis added)).

As discussed above, Forward operates on the principle that inwardly prestressed wings are deflected to mount a roller therein, and thus squeeze the roller when it is in place. If Forward's wings were combined with Lin's frame, the webs which keep Lin's sideplates 11 spaced apart from one another would also prevent Forward's wings from squeezing any roller/wheel. Thus, adding Forward's wings to Lin's device would change the operation of Forward's wings, effectively destroying the "inwardly prestressed" aspect and preventing the wings from squeezing the rollers/wheels.

Since combining Forward with Lin would result in a change of operation of Forward's wings, the proposed combination is improper, and Applicants respectfully request that the Examiner withdraw the rejections based on this combination.

Notwithstanding that the Lin/Forward combination is improper, Applicants will discuss each pending independent claim in turn below.

Independent Claim 1

Even if Lin and Forward were combined, the combination would not teach or suggest all of the limitations of Claim 1. For example, Claim 1 currently recites, *inter alia*, an integrally formed roller skate chassis comprising a pair of laterally spaced first and second longitudinal members, said longitudinal members having generally planar upper portions with upper edges integrally attached to heel and forefoot attachment members and lower portions for accommodating attachment of a wheel set, one of said upper portions of the first longitudinal member being substantially coplanar with a respective lower portion, one of said upper portions of the second longitudinal member being inclined toward the coplanar one of said upper portions in an upwardly extending direction, said lower portions being substantially parallel to each other,

and one or more connecting webs extending between said longitudinal members and integrally attached to said longitudinal members where said upper and lower portions intersect.

A Lin/Forward combination would not teach or suggest all of these limitations. For example, Lin's sideplates are neither coplanar with the legs 22, 32 of the associated brackets 20, 30, nor are they integrally connected with those bracket legs. Further, Forward teaches only symmetrical wings, which is markedly different than the claimed structure. Still further, the Lin/Forward combination gives no indication or suggestion to locate any webs as recited in the claim.

In addition to not being properly combined, the proposed combination does not teach or suggest all of the limitations of independent Claim 1. Applicants respectfully request that the Examiner withdraw the rejection of this claim.

Independent Claim 5

Independent Claim 5 recites, *inter alia*, an integrally formed roller skate chassis comprising heel and forefoot attachment members and a pair of laterally spaced longitudinal members having upper edges integrally attached to said heel and forefoot members. The longitudinal members have upper and lower generally planar portions separated by one or more web members extending between the longitudinal members. The upper portions form substantially convergent planes in an upwardly extending direction above said one or more web members. The lower portions form substantially parallel planes below said one or more web members, such that said chassis forms substantially an A-frame when viewed in cross section.

Even if the Lin and Forward references were combined, such combination does not teach or suggest all of the limitations of Claim 5. For example, Lin's front and rear brackets 20, 30 have hooks that rest upon the sideplates 11, and are not integrally attached thereto. Also, Forward's wings are curved to match the curvature of the spheroid wheel, and Forward does not teach the longitudinal members having upper and lower generally planar portions, nor does the combination give any indication that such upper and lower generally planar portions would be separated by the web members. In fact, there is no teaching in the recited combination how to place any web members, and no teaching that upper portions have planar portions above said one or more web members while simultaneously the lower portions are parallel below said one or more web members.

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With regard to at least the recited web members, the Examiner is reminded that the prior art “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (M.P.E.P. §2141.03(VI) (citing *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983)(emphasis added)). As discussed above, Forward teaches that the wings are inwardly prestressed. If combined with Lin, the web structure of Lin would prevent the wings from being inwardly prestressed, and thus prevent the wings from engaging and squeezing a wheel. Thus, Applicants submit that Forward teaches against using webs. Forward certainly doesn’t suggest where to place a web relative to other components. As such, any Lin/Forward combination cannot teach the recited structure in connection with the web members.

Even if combined, the cited combination does not teach or suggest all of the limitations of independent Claim 5. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of this claim.

Independent Claim 13

Independent Claim 13 has been amended to add the underlined text in the following portions of the claim: “one or more web members extending between and attached to the lower portions of the support members so that the support members are parallel below the one or more web members,” and “the upper portions lie in substantially convergent planes in an upwardly extending direction above said one or more web members, and the portions of the upper portions that lie in substantially convergent planes are each generally planar.”

As such, independent Claim 13 recites, *inter alia*, a roller skate chassis assembly interconnected as a unit, the chassis assembly comprising a pair of laterally spaced longitudinal support members, each support member having a substantially planar lower portion, the lower portions being parallel to each other; one or more web members extending between and attached to the lower portions of the support members so that the support members are parallel below the one or more web members; and upper portions in each of a forefoot and heel section, and in at least one of the heel and forefoot sections, the upper portions lie in substantially convergent planes in an upwardly extending direction above said one or more web members, and the portions of the upper portions that lie in substantially convergent planes are each generally planar.

Even if combined, Lin and Forward would not teach or suggest all of the limitations of Independent Claim 13. For example, the components of Lin and of Forward are not

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interconnected as a unit. Also, although Lin teaches webs at the top and bottom of its channel piece 10, Forward teaches against providing webs, and thus a Lin/Forward combination would give no suggestion as to how the upper and lower portions should be structurally arranged relative to any webs. Further, Forward's wings are curved, which does not satisfy the claim, which requires that the upper portions have portions that are generally planar.

Even if combined, the cited combination does not teach or suggest all of the limitations of independent Claim 13. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of this claim.

Independent Claim 22

Independent Claim 22 has been amended to add the underlined text in the following portion of the claim: “each chassis member being unitarily formed and having a front region . . .”.

As such, independent Claim 22 currently recites, *inter alia*, a roller skate chassis assembly integrated as a unit, said chassis assembly comprising an elongate left chassis member and an elongate right chassis member, each chassis member being unitarily formed and having a front region, a back region, and a substantially planar lower portion extending through the front and back regions, each chassis member having a substantially planar upper portion in the front region and a substantially planar upper portion in the back region, the upper portions being positioned substantially above the one or more web members, and at least one of the upper portions of each of the chassis members lies in a plane that is inclined relative to the adjacent planar lower portion and is convergent in an upward direction with the corresponding planar upper portion of the spaced apart chassis member.

Even if combined, Lin and Forward would not teach or suggest all of the limitations of Independent Claim 22. For example, neither Lin nor Forward teach left and right chassis members being unitarily formed as claimed. Also, as discussed above, Forward's wings curve to approximate the curvature of its spheroid rollers, and thus Forward teaches against substantially planar upper portions. Still further, as discussed above, Forward teaches against providing webs, and thus a Lin/Forward combination would teach against webs and certainly would give no suggestion how to arrange a structure when considering webs.

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Even if combined, the cited combination does not teach or suggest all of the limitations of independent Claim 22. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of this claim.

Independent Claim 36

Independent Claim 36 has been amended to add the text that is underlined in the following excerpt from the claim, and to delete the bracketed text: “at least one web member extending between and attached to the support [members]member lower portions,” and “an upper portion in the heel section of each support member, at least part of each upper portion being substantially planar and lying in a plane that is inclined relative to the lower portion,”

As such, independent Claim 36 currently recites, *inter alia*, a roller skate chassis assembly interconnected as a unit, the chassis assembly comprising a pair of laterally spaced support members spanning forefoot and heel sections of the chassis, each support member having a substantially planar lower portion, at least one web member extending between and attached to the support member lower portions, an upper portion in the heel section of each support member, at least a part of each upper portion being substantially planar and lying in a plane that is inclined relative to the lower portion, the upper portion planes being convergent in an upwardly direction above the at least one web member, and wherein in at least one of the heel and forefoot sections, the upper portions are spaced such that a distance between the upper portions is less than a distance between the planar lower portions.

Even if combined, Lin and Forward would not teach or suggest all of the limitations of Independent Claim 36. For example, neither Lin nor Forward teach a roller skate chassis assembly interconnected as a unit. Also, as discussed above, the wings of Forward are curved to follow the curvature of the spheroid roller, and the cited references thus do not teach or suggest at least a part of each portion being substantially planar and lying in a plane that is inclined relative to the lower portion. Further, as discussed above, the cited combination teaches against web members, and certainly do not teach or suggest a web member arranged with the recited structure.

Even if combined, the cited combination does not teach or suggest all of the limitations of independent Claim 36. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of this claim.

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Independent Claims 29 and 46

Independent Claims 29 and 46 stand withdrawn by the Examiner. However, as discussed above, Applicants respectfully request that these claims be reinstated to consideration. Applicants further submit that these claims are currently in condition for allowance.

Dependent Claims

The pending dependent claims depend from patentable independent claims. They also recite additional patentable subject matter. For instance, the dependent claims recite subject matter such as, for example, the chassis having an extruded unibody construction; the support members being formed separately from one another; each mounting flange extending from its respective upper edge in a direction away from the upper portions; the support members and one or more web member being integrally attached to one another; the left chassis member, right chassis member and one or more web member being formed separately from one another; and at least one of the upper portions of each of the chassis members lying in a plane that is inclined between about 60° - 88° relative to the plane of the lower portion. These limitations are not taught or suggested by the cited references.

Notably, on pages 3-4 of the Office Action, the Examiner contends that it was obvious to provide the upper portions lying in a plane that is inclined between about 60° - 88° relative to the plane of the lower portion. Applicants respectfully disagree. Col. 2, ll. 31-39 of the specification describes advantages that are specific to inline hockey skates. For example this arrangement “is particularly advantageous for the quick movements which occur during roller hockey.” It has been shown to provide “enhanced structural integrity for a given weight and more efficient power transfer.” Such benefits were not realized by others until Applicants invented the recited invention, and Applicants contend that this limitation represents additional patentable subject matter.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other

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broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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